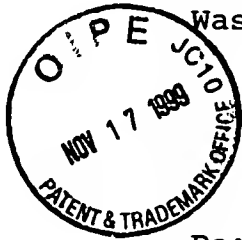


Box Non-Fee Amendments (patents)
Assistant Commissioner for Patents
Washington, D. C. 20231



1 #6/Amdt. B
W Morgan
12/1/99

GP 3713
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RESPONSIVE TO AN OUTSTANDING OFFICE ACTION

Re: Patent Application of Brad A. Armstrong

Serial No.: 08/942,450 Filed: 10/01/97

Title: GAME CONTROLLER WITH ANALOG PRESSURE SENSOR(S)

Applicant's address: Brad A. Armstrong
P.O. Box 1419
Paradise, CA 95967

Examiner: Mr. John Paradiso
Group Art Unit 3713

Dear Sir:
REMARKS

This is responsive to the Office Action mailed 08/18/99 paper #4 which is the first Office Action on the merits of the application. This is also responsive to the 10/08/99 paper # 5 which regards the Oct 7, 1999 telephone interview between applicant Brad Armstrong and Examiner John Paradiso regarding the 08/18/99 Office Action.

Applicant has carefully read and studied the 08/18/99 Office Action and the prior art made of record. The Office Action of 08/18/99 lists claim 1-19 as pending and rejected under 35 USC 103 (a) as being unpatentable over the prior art of record and specifically Inoue et al and Rutledge et al.

The written Interview Summary of paper #5 regarding the Oct 7, 1999 telephone interview between Applicant and the Examiner addressing application 08/942,450 is generally accurate. Discussed in the interview was claim 1 and the claims in general; the prior art of Inoue et al (U.S. Patent 5,207,426) and Rutledge

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et al (U.S. Patent 5,764,219), and the 5 points specified in the PTO paper #5 generally as written therein. Agreement during the interview on patentability of Applicant's invention, at least at that time, was not reached between Applicant and the Examiner.

The five primary points of the Oct. 7, 1999 telephone interview were:

1) that Applicant asked the Examiner as to whether hindsight of Applicant's invention could "possibly" have been improperly applied and thereby lead to the obviousness rejections in the First Office Action on the merits, as Applicant could not and can not find, in the combined and relied upon references of Inoue et al and Rutledge et al, any suggestion of combining features from the two disclosures in order to create, define or simulate Applicant's invention. Furthermore and regarding point 2) of the Oct. 7, interview, Applicant directed the Examiner's attention to the fact that Inoue et al was not listed as prior art in the Rutledge et al disclosure, and that the Inoue et al and Rutledge et al disclosures were each classified differently one from the other in both the International and U.S. Main classifications (not just subclasses), and that when the PTO patent search was performed on the later issued Rutledge et al patent application, that Inoue et al was not reviewed and the field of search did not extend into the same class or class and subclass in which Inoue et al is classed. Furthermore the patent search on the Rutledge et al application apparently did not cross into any of the same classes and subclasses which were searched in the patent search of Inoue et al. The point being made here is that the PTO's own prior actions, being searches conducted by highly skilled Patent Office Examiners, indicate that one of ordinary skill "may" not necessarily and reasonably be charged with having knowledge of both the Inoue et al and Rutledge et al disclosures at the time of the instant invention. Even though the Inoue and Rutledge appear as non-analogous art, the point may be considered moot because the two references when combined fail to suggest the


instant invention in any case. While applicant understands that the MPEP 904.01(c) requests the examiner search "all analogous arts regardless of where classified.", MPEP also states "The determination of when arts are analogous is at times difficult."

Even if Inoue et al and Rutledge et al are analogous art, which is not conceded, Applicant is completely unable to locate anything existing in Rutledge et al which reasonably directs one skilled in the art to make the necessary changes to the Inoue et al game controller to simulate the instant invention (particularly as claimed below in the herein amended claims). Additionally and in reference to the point 3) of the Oct. 7 interview, Applicant fails to see any structure existing in the Rutledge et al disclosure which could in effect be transported over to Inoue et al and applied to the Inoue et al controller to make the hypothetical new controller simulate Applicant's invention, assuming there was some suggestion to make such a new combination existing in the Inoue et al and Rutledge et al disclosures, which there is not. Regarding the point 4) of the Oct. 7, interview wherein Applicant informs the Examiner that Applicant believes commercial success has been achieved with the invention in that a license agreement was entered into between Applicant and a business entity (licensee) having significant knowledge in this field, wherein the licensee has made a non-refundable advance of royalties of \$50,000.00 U.S. dollars to Applicant for rights to make, use and sell the instant invention. A copy of the royalty advance check is hereto attached, and details regarding the significance of the check and the expertise and judgement of the licensee from which it came will be discussed in remarks following amendments to the claims. Applicant very respectfully requests that the Examiner carefully consider the license and \$50,000.00 royalty advance, in that Applicant believes substantial weight must be given to such facts in making a proper determination of inventiveness, particularly when the expertise of the licensee as a whole is taken into account. Furthermore, this application is very important to



Applicant's financial future. Financial harm will come to Applicant "if" it takes too long for this application to issue as a patent, for example, should it take Applicant many continuations to convince the Examiner of the Patentability. Applicant hopes a long prosecution period for this application can be avoided, as Applicant firmly believes the invention advances the art in the manner which our founding Fathers intended to be patentable.

Regarding the point 5) of the Oct. 7, 1999 interview wherein Applicant basically states that if in fact the invention were rendered obvious by the prior art, then it would reasonably follow that some prior art embodiment the same as the instant invention should be present in the prior art, and this would be reasonably expected because of the desirable benefits and advantages provided by the instant invention. The benefits and advantages of the instant invention are readily apparent from the instant specification and are appreciated by not only Applicant but also apparently by the Examiner as evidenced by the Examiner's statement in the last line of page 3 of the 08/18/99 Office Action wherein it is stated "in order to provide a more natural, intuitive feel for the controller." Applicant states it and understands the invention provides clear advantages over the nearest prior art device, and the Examiner seems to agree with such. There is no single prior art device offering such advantages, and it would seem that there would be if in fact the invention were obvious in view of the prior art, thus, there exists strong and compelling evidence that the instant invention is not only novel, but is unobvious and should in fact be held allowable over the prior art of record. Inoue et al do not hint at analog or analog associated with depressible surfaces, and Rutledge et al appear to only be concerned with a variable speed pointer/cursor manipulable through manipulation of a tiltable joystick, and thus again applicant fails to see any type of suggestion in the Inoue et al and Rutledge et al disclosures which would properly suggest the instant invention in terms of



structure, methodology or benefits and advantages.

Applicant read paper #5 and believes it to be generally accurate as to the substance of the interview, but believes Applicant probably failed to clearly communicate the finer points to the Examiner. However, Applicant strongly believes allowable subject matter exists in the application (and the newly amended claims presented below), and is encouraged by the Examiner pointing out (thank you) in paper #5 "specific facets of the invention not claimed". Applicant, is hopeful and, believes the Examiner will find the below amended claims allowable.

Applicant notes with appreciation that the drawings are fully acceptable to the Official Draftperson as stated in the PTO form 948 included with the 08/18/99 Office action.

Applicant will amend the claims of the application prior to making remarks supporting the allowability thereof over the prior art of record, and this so that the remarks can be directed toward the claims as amended.

AMENDMENTS

Amendments to the Specification

In order to correct minor errors in the originally filed Specification, please make the following changes therein. These changes will also make the specification more clear and consistent with the wording of the claims as amended, without adding any new matter. No new matter has been added.

~~On~~ page 2, line 9, please change "momentary On" to read
--momentary-On--.

~~On~~ page 2, line 13, please change "momentary On" to read
--momentary-On--.

~~On~~ page 3, line 16 following "analog", please insert
--pressure--.

